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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,811	02/04/2002	Thomas E. Ward III	IS/074 CONT 4.	6065
7590 Alexander Shvarts Fish & Neave 1251 Avenue of the Americas New York, NY 10020-1105		06/19/2007	EXAMINER PENG, FRED H	
			ART UNIT 2623	PAPER NUMBER
			MAIL DATE 06/19/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/066,811

Applicant(s)

WARD ET AL.

Examiner

Fred Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/18/2007 has been entered.

Priority

2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows: The earliest of filed applications that appears to provide adequate support is 60/055,761. Therefore the application is being examined based on priority date of 08/14/1997.

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DETAILED ACTION

Response to Arguments

3. Applicant's arguments with respect to claims 1-61 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-2, 6-7, 9-10, 15, 17-20, 24-25, 28, 33, 37-39, 43-44, 47, 51 and 55-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hite et al. (US 5,774,170) in view of Coleman et al (US 5,844,620).

Regarding Claims 1 and 57, Hite discloses a method and a computer readable medium having stored thereon a set of instructions for displaying an advertisement (Col 3 lines 21-23), when executed by a microprocessor, cause the microprocessor to perform the step of:

receiving advertisement information (Col. 3 lines 21-23).

However, Hite fails to disclose steps of storing TV schedule in a database;

modifying, at a user equipment, a portion of the advertisement information to include a portion of the stored TV schedule information to form a modified advertisement;

displaying a plurality of television schedule listings in a first area of a screen; and displaying the modified advertisement in a second area of the screen.

In an analogous art, Coleman discloses storing TV schedule in a database (FIG.2, -50; Col 8 lines 32-34);

modifying, at a user equipment, a portion of the advertisement information to include a portion of the stored TV schedule information to form a modified advertisement (FIG.8; Col 21 lines 19-24; the received advertisement 200 is modified with the program guide 210 and program information 295);

displaying a plurality of television schedule listings in a first area of a screen (FIG.8, 210); and displaying the modified advertisement in a second area of the screen (FIG.8, 200)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hite's method to include modifying a portion of the received advertisement information at a user equipment and displaying a plurality of television schedule listings in a first area of a screen; and displaying the modified advertisement in a second area of the screen, as taught by Coleman so attributes of other programming services are available on other channels are determined while continuity of viewing is maintained (Col 1 lines 24-26).

Regarding Claim 2, Coleman further discloses method is performed in substantially real time (In response to user command is substantially real time).

Regarding Claim 6, Coleman further discloses storing a program description and combining a portion of the received advertisement with stored program description (FIG.8).

Regarding Claim 7, Coleman further discloses storing a program telecast time and combining a portion of the received advertisement with stored program telecast time (FIG.8).

Regarding Claim 9, Coleman further discloses storing an info related to a geographical location and combining a portion of the received advertisement with the info related to a geographical location (Col. 4 lines 13-24).

Regarding Claim 10, Coleman further discloses storing info related to a TV viewer and combining a portion of the received advertisement with the info related to a TV viewer (Col. 4 lines 13-24).

Regarding Claims 15 and 17, Coleman further discloses steps of selecting the displayed info using a pointing device and activating a function related to the selected info and display more detail info related to the selected info (FIG.8, Col 21 lines 24-30).

Regarding Claims 18, 19 and 37, Coleman further discloses step of activating a function comprising scheduling future and currently telecast TV program for recording (Col. 3 lines 36-38).

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Regarding Claims 20 and 58, Hite discloses a method and a computer readable medium having stored thereon a set of instructions for displaying an advertisement, when executed by a microprocessor, cause the microprocessor to perform the step of:

storing advertisement info in a 2nd database (FIG.5, -456).

However, Hite does not disclose storing television schedule information in a first database;

overlay, at a user equipment, a portion of television schedule information from the first database onto a portion of the advertisement information to form a modified advertisement;

displaying a plurality of television schedule listings in a first area of a screen; and

displaying the modified advertisement in a second area of the screen.

In an analogous art, Coleman discloses storing television schedule information in a first database (FIG.2, -50);

overlay, at a user equipment, a portion of television schedule information from the first database onto a portion of the advertisement information to form a modified advertisement (FIG.6; portion of schedule information 210 overlays portion of the advertisement 200);

displaying a plurality of television schedule listings in a first area of a screen (FIG.6, 210);
and

displaying the modified advertisement in a second area of the screen (FIG.6, 200).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hite's system to include overlaying, at a user equipment, a portion of television schedule information from the first database onto a portion of the advertisement information to form a modified advertisement, as taught by Coleman so that the commercial program is not interrupted while browsing other interesting channels.

Regarding Claim 24, Coleman further discloses storing schedule info step comprising storing a program description and the overlaying steps comprising overlaying the stored program description onto a portion of the stored advertisement information (FIG.6).

Regarding Claim 25, Coleman further discloses storing schedule info step comprising storing a program telecast time and the overlaying steps comprising overlaying the stored program telecast time onto a portion of the stored advertisement information (FIG.6, 230, 232, 234).

Regarding Claim 28, Coleman further discloses storing schedule info step comprising storing info related to a TV viewer and the overlaying steps comprising overlaying the stored info related to a TV viewer onto a portion of the stored advertisement information (Col. 4 lines 13-24; the related viewer information is part of EPG).

Regarding Claim 33, Coleman further discloses the steps of selecting the displayed advertisement using a pointing device and activating a function related to the selected advertisement (Col 4 lines 22-24).

Regarding Claim 38, Coleman further discloses the steps of activating a function comprising tuning to a currently telecast television program (Col 3 line 36).

Regarding Claims 39, 43-44, 47, 51, 55 and 56, the system claims have been discussed with regards to the method Claims of Claims 20, 24-25, 28, 33, 37 and 38.

Regarding Claim 59, Coleman further discloses overlaying the stored television schedule information onto the received advertisement information (FIG.6).

Regarding Claims 60-61, Coleman further discloses replacing a text or graphical portion of the received advertisement information with the stored television schedule information (FIG.6).

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6. Claims 3-5, 8, 11-14, 16, 21-23, 26-27, 29-32, 34-36, 40-42, 45-46, 48-50, and 52-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hite et al. (US 5,774,170) and Coleman et al (US 5,844,620) as applied to claims 1, 15, 20 above, and further in view of Schein et al (US 2003/0005445 A1)

Regarding Claims 3, 13, 14, 31 and 32, Hite and Coleman discloses limitations in Claims 1, 15, 20 and 33.

Hite and Coleman do not disclose promotional information about a future TV program or product is a video preview.

In an analogous art, Schein discloses promotional information about a future TV program or product is a video preview (Para 129, Para 133 lines 21-23).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Hite and Coleman to include promotional information about a future TV program is a video preview, as taught by Schein as one of the common ways to promote future program.

Regarding Claims 4-5, and 21-23, Schein further discloses promotional info about a currently telecast and future TV program, and products and service (Para 129, Para 133 lines 21-25).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Hite and Coleman to include promotional information about currently telecast and future TV program, and products and service, as taught by Schein as one of the common ways to promote programs and products.

Regarding Claims 8, 16, 26 and 34, Schein further discloses storing a web site address and combining a portion of the received advertisement with stored a web site address and

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activating a function comprising linking to a web site based on an address related to the selected info and displaying more info from the web sites (Para 139 lines 1-11, Para 144 lines 8-12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Hite and Coleman to include storing a web site address and combining a portion of the received advertisement with stored a web site address and activating a function comprising linking to a web site based on an address related to the selected info and displaying more info from the web sites, as taught by Schein as one of the common ways to access more information from the internet.

Regarding Claim 27, Coleman discloses overlaying steps comprising overlaying the stored schedule information onto a portion of the stored advertisement information (FIG.6).

Coleman is silent about storing schedule info step comprising storing a geographical location.

Schein discloses storing schedule info step comprising storing a geographical location (Para 119 lines 1-11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Hite and Coleman to include storing schedule info step comprising storing a geographical location, as taught by Schein to provide more specific information based on geographical location.

Regarding Claim 35, Schein further discloses the steps of activating a function comprising more detail info related to the selected advertisement (Para 127 lines 1-6).

Regarding Claim 36, Schein further discloses the steps of activating a function comprising displaying a video preview related to the selected advertisement (Para 133 lines 21-26).

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Regarding Claims 11-12 and 48, Schein also discloses the 1st database includes info related to rotating ad info in the EPG for combining a portion of ad data with the stored info related to rotating ad info and further display the advertisement info in the EPG based on the rotating advertisement info (FIG.16A, Para 134 lines 4-9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Hite and Coleman to include database includes info related to rotating ad info in the EPG for combining a portion of ad data with the stored info related to rotating ad info and further display the advertisement info in the EPG based on the rotating advertisement info, as taught by Schein to provide more specific information with limited space.

Regarding Claims 29 and 30, Coleman discloses overlaying the information onto a portion of the stored advertisement information (FIG.6).

Coleman is silent about storing schedule info step comprising storing info related to rotating advertisement info in the EPG.

Schein discloses the 1st database includes info related to rotating ad info in the EPG for combining a portion of ad data with the stored info related to rotating ad info and further display the advertisement info in the EPG based on the rotating advertisement info (FIG.16A, Para 134 lines 4-9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Hite and Coleman to include database includes info related to rotating ad info in the EPG for combining a portion of ad data with the stored info related to rotating ad info and further display the advertisement info in the EPG based on the rotating advertisement info, as taught by Schein to provide more specific information with limited space.

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Regarding Claims 40-42, 45-46, 49-50 and 52-54, the system claims have been discussed with regards to the method Claims of Claims 21-23, 26-27, 31-32 and 34-36.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred Peng whose telephone number is (571) 270-1147. The examiner can normally be reached on Monday-Friday 08:30-18:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Patent Examiner

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